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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/192,303 11/17/98 DEGUCHI

M 0052327

WM01/1108
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2100 PENNSYLVANIA AVENUE N W
WASHINGTON DC 20037

EXAMINER

CHIANG, J

ART UNIT

PAPER NUMBER

2642

DATE MAILED:

11/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/192303

Applicant(s)

M. Deguchi

Examiner

J. Chiang

Group Art Unit

2642

#17

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9-12-2001.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 14-44 is/are pending in the application.
- Of the above claim(s) 14-23, 31-35, 41, 44 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 24-30, 36-40, 42-43 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of References Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

RESTRICTION

1. The restriction dated on 8-13-01 is made final.

CLAIMS

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 24-30, 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Sudo et al. (US 5987336).

Regarding claim 24, Sudo shows:

Displaying, in a first user interface (i.e. display 35) on a housing (31) having a second user interface (sound transmitter 34) on the same side as the first interface, a menu having items and a highlight bar (see items and K in fig. 26);

Moving the highlight bar (UP and DOWN key in fig. 6);

Executing the selected item (CLICK in fig. 6).

Regarding claim 43, Sudo shows a method for selecting one of the items displayed in rows and columns comprising:

Moving a highlighted portion (see cursor K in fig. 26) by a movement key (UP and DOWN key in fig. 6), only items on the column is allowed to be scrolled;
Executing the highlighted portion (K) by an execution key (CLICK key in fig. 6).

Regarding claims 25-30, Sudo shows:

Scrolling the highlight bar, the memory, and items on the display (see fig. 26);
Reading and arranging the data (see fig. 26);
Selecting and executing a communication address (see fig. 18);
The portable telecommunication device (fig. 6)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 36-39, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudo in view of Davidson et al. (US 5774540).

Regarding claim 36, Sudo shows:

A display section (i.e. 35);

A key section (i.e. 36);

A first key section including a movement key pad which moves a highlighted portion (UP and DOWN key in fig. 6, cursor K in fig. 26), and an execution key (CLICK in fig. 6);

A second key section including a ten key pad (36b-d);

The display section (35) displays items in rows and columns (see fig. 26);

The movement key allows items on a column to be scrolled (see K in fig. 26).

Sudo differs from the claimed invention in that the first (movement) key section and the second (ten-key) key section are not on the one side below the display.

However, it is commonly seen that the movement key and the ten-key are on the same side. This is taught by Davidson, such as the movement key (221-223) and ten-key (numeral keys). Further, the law also states that shifting location of parts does not constitute patentable weight (*In re Japikse* 86 USPQ 70, CCPA 1950). Hence, it would have been obvious for one skilled in the art to shift Sudo's movement key onto the same side as the ten-key with/without the teaching of Davidson. This simply can be considered as a variation or shifting part to different location in Sudo, because the basic concept of providing such movement key and ten-key, including their operation, is substantially unchanged.

Regarding claims 37-39, 42, the combination of Sudo and Davidson shows:

The first key section which has the movement key and the execution key (see 36J in Sudo; 221-223 in Davidson);

The movement key having plurality of keys (UP and DOWN in Sudo; 221, 223 in Davidson);

the execution key which is sandwiched by contacts of the movement key (CLICK, UP and DOWN in Sudo; 222, 221, 223 in Davidson); and

the first and second key sections are in one housing (fig. 6 in Sudo; fig. 2 in Davidson).

6. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sudo and Davidson in view of JP6-232992.

Regarding claim 40, the combination of Sudo and Davidson shows the movement and execution key.

The combination differs from the claimed invention in that it is not the single lever-type key which is inclined and depressed to close the contacts.

However, JP6-232992 teaches providing the single lever-type key which is inclined and depressed to close the contacts (see 202-205 in fig. 2; see also equivalent key operation in 402-406 in fig. 4). Hence, it would have been obvious for one skilled in the art to replace the key of the combination of Sudo with the single lever-type key shown by the JP reference. This can be considered as an intended use of the JP reference. It is also understood that all of these references (Sudo, Davidson, and JP6-232992) disclose the combination of the movement key and the execution key, and replacing one type of key with the other can be considered as a variation of each other, because the basic requirement for moving the cursor (movement key) and executing the key is substantially unchanged.

ARGUMENT

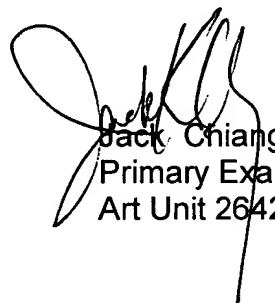
7. In response to the remarks, pages 6-8, Macor and its combination are withdrawn in view of the amendment. New references are cited, see rejection above.

Art Unit: 2642

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Admad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



Jack Chiang
Primary Examiner
Art Unit 2642